

Application Serial No. 10/083,810

Reply to non-Final Office Action dated January 14, 2005

**REMARKS/ARGUMENTS**

The preceding amendments and following remarks are submitted in response to the Office Action mailed January 14, 2005, setting a three-month shortened statutory period for response ending April 14, 2005. Claims 1-3, 6-7, 10-11, and 17 remain pending in the Application. Reconsideration, examination and allowance of all pending claims are respectfully requested.

**35 U.S.C. § 103(a) Rejections**

In paragraph 1 of the Office Action, the Examiner rejected claims 1-3, 6-7, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Tsugita et al.* (U.S. Patent No. 5,911,734) in view of *Pinchuk et al.* (U.S. Patent No. 6,254,633). The Examiner states that *Tsugita et al.* disclose a filter system comprising a wire having a proximal end and a distal end, a filter for collecting debris from a body lumen having a support frame, an outer shaft, an inner shaft, and a coil spring adapted to cause radial expansion of the filter. The Examiner acknowledges that *Tsugita et al.* fails to disclose a dilator tip, but instead states that the *Pinchuk et al.* reference discloses this feature. According to the Examiner it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Tsugita et al.* by including a dilator tip slidably disposed in the distal sheath in view of *Pinchuk et al.* to aid navigation of the device through a body lumen.

Applicants respectfully assert that claims 1-3, 6-7, and 17 are patentable over *Tsugita et al.* in view of *Pinchuk et al.* In *Tsugita et al.*, the spring coil (206) is configured to apply an inwardly directed compressive force on the filter struts (203) that causes the struts (203) to radially expand when the filter frame is unconstrained radially. This is readily apparent from the inwardly directed arrows shown in Figure 15A, which depict a compressive force applied

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to the filter struts (203) by action of the spring coil (206). During operation, actuation of the filter assembly in *Tsugita et al.* is accomplished manually by pushing the guidewire (40) distally, causing the filter frame to exit the inner lumen and radially deploy within the body. See *Tsugita et al.* at col. 3, lines 48-62.

In contrast to the filter system and device recited in independent claims 1 and 17 of the present Application, the spring coil (206) in *Tsugita et al.* does not act to bias any portion of the filter assembly *in a distally advanced position* (as in claim 1) or *toward the distal end of the distal sheath* (as in claim 17), but instead exerts an inwardly directed force on the filter struts (203) that serves to pull the filter open when radially unconstrained. Such inwardly directed force would therefore not act to “bias the tip 204 as a result of the radial contraction or expansion of the struts,” as asserted by the Examiner on page 3 of the Office Action. Since neither *Tsugita et al.* nor *Pinchuk et al.* disclose or suggest a spring coil adapted to bias any portion of the filter assembly in a distally advanced position and/or toward the distal end of the distal sheath, Applicants assert that the cited prior art fails to disclose each and every element of claims 1 and 17. Accordingly, Applicants respectfully assert that claims 1 and 17 are patentable over the cited prior art.

Because claim 1 is patentable, Applicants respectfully assert that dependent claims 2-3, 6-7, and 10-11 are also patentable for the reasons stated above, and since they add other significant elements to distinguish them from the prior art.

#### **Allowable Subject Matter**

In paragraph 2 of the Office Action, the Examiner states that claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would otherwise be allowable

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if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants respectfully assert that since base claim 1 is allowable over the cited prior art, dependent claims 10 and 11 are also in condition for allowance.

**Finality of Office Action**

On page 3 of the Office Action, the Examiner states that the Office Action has been made final, citing the provisions of MPEP § 706.07(a). In box 2(a) of the Office Action Summary sheet, however, the Examiner indicates that the present Office Action is non-final, creating confusion as to the finality of the Office Action. An attempt on 2/21/05 to contact the Examiner to clarify this discrepancy was unsuccessful.

Applicants respectfully assert that the finality of the current Office Action is inappropriate in view of MPEP § 706.07(b). In particular, paragraph 2 of Section 706.07(b) provides:

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) *new issues were raised that required further consideration and/or search*, or (B) the issue of new matter was raised.

(emphasis added).

In the Advisory Action mailed on October 8, 2004, the Examiner indicated in box 2(a) that the prior Amendment filed on June 2, 2004 would not be considered because the amendments contained therein “raise new issues that would require further consideration and/or search.” Since the prior Amendment filed on June 2, 2004 was never entered, and since the current Office Action is a continuation (*i.e.* RCE) application, Applicants respectfully assert that the finality of the current Office Action is improper and should be

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withdrawn, pursuant to MPEP § 706.07(b). Accordingly, Applicants have filed this Amendment under the provisions of 37 C.F.R. § 1.111 governing non-final amendments.

In view of the foregoing, all pending claims are believed to be in condition for allowance. Reexamination and reconsideration are respectfully requested. If the Examiner would like to discuss the application or its examination in any way, please call the undersigned attorney at (612) 677-9050.

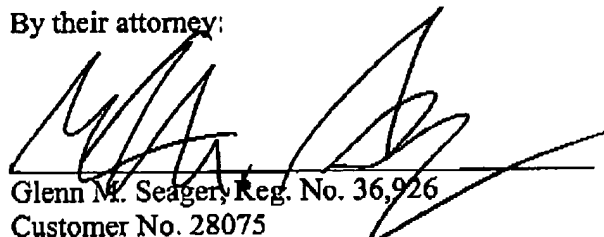
Respectfully Submitted,

JOSEPH GARNER ET AL.

By their attorney:

Date:

*April 12, 2005*



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